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IN THE

Supreme Court of the United States

OCTOBER TERM, 1934

No. 208

HERBERT H. WAXHAM, DOING BUSINESS AS WAXHAM HATCHERIES,

Petitioner,

vs.

SAMUEL B. SMITH AND THE BUCKEYE INCUBATOR COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

DRURY W. COOPER,
RAYMOND I. BLAKESLEE,
ALLAN C. BAKEWELL,
Counsel for Petitioner.

The Evening Post Job Printing Office, Inc., 154 Fulton St., New York, N. Y.

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IN THE

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vs.

SAMUEL B. SMITH and THE BUCKEYE INCUBATOR COMPANY,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Herbert H. Waxham, doing business as Waxham Hatcheries, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a part of the decree of that Court entered April 9, 1934, in a suit for alleged infringement of a patent.

A transcript of the record in the case including the proceedings of said Circuit Court of Appeals has been furnished in accordance with the rules of this Court.

The opinion of the Court of Appeals for the Ninth Circuit is included in Vol. 1 of the Record, at page 671, and reported in 70 Fed. [2d] at page 457.[1]

Summary Statement of the Matter Involved.

This is a suit in equity brought in the United States District Court for the Southern District of California, Central Division, by Samuel B. Smith and The Buckeye Incubator Company, for alleged infringement of a patent relating to improvement in incubators for hatching eggs. Petitioner is the owner and operator of a hatchery located in the City of Van Nuys, State of California, and is sued because of his use of an incubator manufactured and sold by the Robbins Incubator Company, of Denver, Colorado, and constructed and operated in accordance with Reissue Letters Patent No. 18,984, issued to John L. Robbins, of that company, October 31, 1933. The manufacturer was not a party to the suit.

Petitioner, by this petition, seeks to bring before this Court, for review, so much of the decree of the Circuit Court of Appeals for the Ninth Circuit (Rec. Vol. 1, p. 683) as held valid and infringed claim 1 of patent No. 1,262,860, issued April 16, 1918, on application filed October 26, 1916. Plaintiffs charged infringement of claims 1 and 2 of the patent, both purporting to cover a method of hatching eggs in an incubator.

Trial was had before a master on reference made by the Hon. Paul J. McCormick, Judge of the District Court (Rec. Vol. 1, p. 25). After trial, the master rendered a report (Vol. 1, p. 27) which was later supplemented by an additional report (Vol. 1, p. 90). The master held claim 1 of the patent valid and so interpreted the claim as to hold that it was infringed by defendant. Claim 2 was held valid, but not infringed. Judge McCormick (Vol. 1, p.

[1] Emphasis, by italics, in petition and brief, is ours unless otherwise stated.

106) adopted the master's reports and entered a decree on August 2, 1932, for injunction as to claim 1 and for nominal damages[1] and costs (Vol. 1, p. 129).

Both parties appealed from the decree, but plaintiffs abandoned their appeal as to claim 2 and did not present the matter in either briefs or argument before the Court of Appeals.

The opinion of the Court of Appeals affirming the District Court as to claim 1 is printed at page 671, Vol. 1, of the record, and reported in 70 Fed. [2d] at page 457.

On May 7, 1934, petitioner filed a petition for rehearing, which was denied June 15, 1934.

The Patent in Suit.

The patent in suit relates to a large sized incubator for hatching eggs. In the structure of the patent (Fig. 1, Vol. 2, p. 3), egg trays having meshed bottoms are arranged in vertical tiers. A series of tiers are grouped in each of two side chambers. Between said chambers is a passageway (5) called a "corridor". This is partitioned by a curtain on each side (3 and 4), which curtains act as walls between the central corridor and the two side compartments. These curtains do not extend to the floor, but end several inches above it. The two side compartments or chambers contain tiers of egg trays, while the third compartment, or central corridor, is for air distribution.

A motor driven fan (18) is positioned at the top of the corridor in close relation to coils of heated pipes. The top of the incubator box is provided with an inlet opening for admitting fresh air, and with outlets for the release of foul air. The circulation of air is accomplished by the fan which forces air downwardly through the central cor-

[1] An accounting was waived (Vol. 1, p. 131) so the decree entered was a final decree.

ridor. The current of air strikes the floor of the corridor, passes under the lower ends of the curtains at either side of the corridor, and then up through the tiers of egg trays, and back to the fan.

The structure is thus described by the patentee (Vol. 2, p. 4, lines 65-73):

> "The invention comprises a walled chamber 2 • • • subdivided longitudinally by two parallel rows of curtains 3 and 4 to provide a central compartment or corridor 5 and side compartments 6 and 7." (Egg tray tiers.)

In the use of the incubator, the new eggs are placed in trays in the top racks of the tiers for three days, and thereafter every three days during the next fifteen day period the trays containing the eggs are moved progressively downwardly in the tier. The total period of incubation is twenty-one days, and the specification provides for the placing of a new set of trays containing fresh eggs each three days in the places left vacant by those trays which have already been shifted to a lower level in the tiers. When the eggs in a tray are about ready to hatch, the tray is moved into the stationary racks at the bottom of the egg chambers. These lowermost racks are at the level of the lower ends of the curtains which separate the egg tray tiers from the central corridor. This system of progressively adding new eggs in the tiers has long been known as "staged incubation".

The reason for the procedure as described in the specification, is that during the first half of the incubation period the eggs do not themselves generate sufficient heat to properly incubate (100° to 105°) so that heated air must be supplied to them; but during the latter half of the period more heat is generated by the eggs themselves, as the embryos develop, than is required for the proper incubation of an egg; and for best results, the excess heat is carried away and transferred to the cooler eggs which are in the earlier stages of incubation. The circulation of

air in the Smith incubator is accomplished by the motor-driven fan (18) which forces air downwardly through the closed central corridor (5); the current of air then strikes the floor of the incubator and passes under the lower ends of the curtains at either side of the corridor and up between the warmest eggs which are in the hatching trays at the bottom, and thence up through the mesh bottoms of all of the incubating trays in the entire series of tiers in each side chamber, and back to the fan. In making the circuit, some of the old foul air is expelled through the outlets (28) and some new fresh and cool air is drawn in at the inlet (24), and moisture added by pipe (26). In each circuit or cycle there is thus a new mixture of air and moisture, and also of added heat received from pipes (23).

By reason of the curtains, the air stream on its downward travel is confined in the corridor, and the curtains likewise confine and direct all of the air travelling upward through the egg tiers. The air is compelled to move in defined channels. No air can escape around the edges of the trays in its upward travel, but all must pass through the bottom of each tray progressively from the lowest trays holding the warmest eggs, to those at the top holding the newly placed and coolest eggs.

> "• • • it will be also noted that the vertical spaces 27 between the adjacent tilting racks 10 are closed at their lower ends by flexible strips of fabric which are attached to and extend upward at each side of each rack so as to compel the air to circulate through the mesh bottom and around and about each egg as heretofore referred to, and as the eggs further advanced in incubation are contained in these lower trays and as the danger is that the temperature will rise in these eggs to a point injurious to incubation the improved method disclosed herein permits the circulating air to act as a medium to prevent the overheating at this stage of incubation and this is accomplished by promoting an induced draft within the lower trays" (Spec. Vol. 2, p. 5, lines 56-73).

Some of the claims (not in issue) are directed to the apparatus described, and claim 1, which alone is in suit, is asserted in terms of a purported method:

> "1. The method of hatching a plurality of eggs by arranging them at different levels in a closed chamber having restricted openings of sufficient capacity for the escape of foul air without undue loss of moisture and applying a current of heated air, said current being created by means other than variations of temperature and of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature, whereby the air will be vitalized, the moisture conserved and the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage for the purpose specified."

It will be seen that the "whereby" clause—which purports to state the results (a) of "vitalizing" the air, (b) conserving the moisture of the eggs, and (c) carrying the units of heat from the eggs in *the more* advanced stage of incubation to those in a less advanced stage—depends for its fulfillment, particularly as to the last item, upon the first step of the method stated, that is, upon arranging the eggs *at different levels* in the closed chamber. The specification and drawings make it entirely clear that the arrangement is of the warmest eggs, near hatching, at a different level—toward the bottom—from the fresher eggs, toward the top. This is the *sole* teaching of the patent as to egg arrangement, and such arrangement *necessitates* periodical downward movement of the eggs.

In defendant's practice the trays of eggs in all stages of incubation are arranged *indiscriminately as to warmer and cooler eggs, and not at different levels, as is taught by the Smith patent.* Defendant's trays are never shifted in position until the last three days, when the eggs are ready to hatch. Then the trays are removed from the incubator, and the eggs transferred to other trays (hatching trays), which are placed back in the incubator, at one side—not under the cooler eggs in earlier stages of incubation.

This both raises the principal question of infringement and constitutes the main point of difference of construction of the claim among the various Circuits. The Court of Appeals held the claim to cover the defendant's practice, which thus makes the claim cover *any* arrangement of the eggs in an incubator and blowing heated air upon them at such rate as to keep the air at the same temperature, if only the essential functions are performed—of "vitalizing" the air (*i. e.,* freshening it up from time to time), conserving the moisture, and carrying heat from warmer to cooler eggs. Thus the claim is made to cover the essential functions of every incubator since the artificial hatching of eggs was introduced. Furthermore, the claim is thus made to cover blowing air in a single open space without definite confined channels, which is likewise totally foreign to the only teaching of the patent.

Other Litigation on the Claim Here in Suit.

The decision of the Court of Appeals sought to be reviewed is in direct conflict as to the single claim involved, with the decision, rendered only a few days later, of the Court of Appeals for the Eighth Circuit, in *E. H. Snow, et al* v. *Samuel B. Smith,* 70 Fed. [2d] 564. The incubators operated by the defendants in the two cases are substantially identical. The Court of Appeals for the Eighth Circuit analyzes the disclosure of the specification, and concludes that the *arrangement of the eggs* and the *control and direction of the air currents* are essential features of the Smith patent, and that claim 1 must be limited to the procedure specified (at 567, 568):

> "• • • All through the specifications and in each of the method claims runs the purpose of carrying the excess heat of the advanced eggs away from them in order to keep them below 105 degrees and of conveying such heat units to the earlier eggs in order to help maintain them at about 100 degrees. The last

above quotation afforded an arrangement, location, and change of location of eggs in three progressive stages of incubation which would work out the very idea of cooling the advanced eggs and conveying their excess heat units to the cooler eggs. * * *"

"From the above, it would seem that the *arrangement, location, and change in location of the eggs at various stages of incubation was an essential feature* of the disclosure. Nowhere is there a suggestion that the patentee has discovered that the desired results can be reached without or by some other arrangement, location or changes. Having disclosed this as an essential of his method with no hint, revelation, or teaching to the contrary the broad claim to arrangement of the eggs 'at different levels' cannot be extended to an arrangement of trays in a tier which alternates fresh and advanced eggs and where a tray is never moved from its position during the entire incubation period. The disclosure is limited to positions, in the egg column, of eggs in different 'stages' of incubation and the change or shift of such positions—the eggs in the 'early' stage of incubation are in one position where they remain a 'pre-determined time' when they are shifted to another place in the column; from this second position, they are (after remaining a 'pre-determined time') again shifted to a third position in the column."

So limited, the claim is not infringed by either the incubator before the Court in the *Snow* case or the incubator operated by your petitioner. (At 568):

"Appellants' device is based on an entirely different method. As to arrangement of eggs, it mixes up those in various stages of incubation—not in the same tray but as to trays, there is no part of the egg column set aside to eggs in a particular stage but trays of eggs in one stage are layered in with trays in other stages in a predetermined order. Another difference is that a tray is never moved when once placed in the column. As to the air currents, the arrangement is different. The conception and operation of appellee's device is a column of air passing through the column of eggs in a definite direction—

from eggs in advanced stages to those less advanced. In appellants' device, the conception and operation is a wide, general diffusion of air kept moving around all of the eggs without relation—as to direction—to the location of eggs in particular stages of incubation. In fact, the arrangement of eggs by appellants could not permit of such directioning of air currents.

"Thus differing in both essentials of the patent—arrangement of eggs and air current—from the device disclosed by the patent, appellants' device is not infringing."

Upon another point, there is likewise a sharp disagreement between the Circuit Courts of Appeals of the Third and Sixth Circuits and the Circuit Court of Appeals for the Ninth Circuit in the instant case. In the case of *Buckeye Incubator Co.* v. *Hillpot,* 24 Fed. [2d] 341, the Court of Appeals for the Third Circuit held claim 1 necessarily limited, by the disclosure of the specification and by estoppel in the Patent Office, to a method in which there is a *closed corridor,* between curtains, which confines and directs the air current. This is the central compartment of the patent, mentioned above, which contains no eggs, but is utilized for air distribution only (p. 344):

"• • • Looking for the invention by reading the claims in the light of the specification and the file wrapper history of the patent prosecution, *one fixed and definite thing is disclosed, first with reference to its presence in the apparatus and next with reference to its use in the methods. That is a 'corridor' between tray tiers, and a corridor of a kind defined by its purpose.* The specification describes this by saying:

" 'The invention comprises a walled chamber • • • subdivided longitudinally by two parallel rows of curtains *3* and *4* to provide a central compartment or corridor *5* and said compartments *6* and *7*' (tray tiers).

"This physical arrangement is provided specifically to perform the function of maintaining and directing the air current created by the motor driven fan. With-

> out such an arrangement the air would go where it pleased. With such an arrangement the air, confined in a corridor partitioned from the tray tiers by curtains, will move in a current or column to the point of outlet which usually is at the bottom of the corridor, when, after mushrooming, it will pass below the tiers and ascend through the egg trays in a current or column because it is confined there by the same curtains that first prevented its escape from the corridor. The essence of the invention therefore is forced circulation of heated air in predetermined direction, or, stated differently, forced circulation of columns of heated air through columns of eggs."

Like petitioner here, the defendant in the *Hillpot* case did not use the closed corridor of the Smith patent and so was held not to infringe (p. 344):

> "Turning to the specifications for light upon the claims, we find nothing there suggested in respect to air movement except by currents in predetermined directions. With all this before him what did Hillpot do? He simply omitted curtains. He thus transformed the corridor of Smith into the passageway of the old art."

The Court of Appeals for the Sixth Circuit has had this Smith patent before it in four cases. In the first case it held claim 1 infringed by the operation of a structure almost identical with the structure disclosed in the Smith patent, but has always held the claim limited, and not infringed by use of an incubator which did not have Smith's closed passageway for the control of direction of the air currents down through a closed corridor and up through the columns of egg trays. This interpretation of the claim is in agreement with the rulings of the Courts of the Third and Eighth Circuits, and directly contrary to that of the Ninth Circuit here sought to be reviewed.

The fourth case came before that Court in a suit brought by one who was a defendant in an earlier suit in the Court for the District of Indiana, seeking to enjoin a suit for

infringement in the Courts of the Sixth Circuit because of the earlier decree in the Indiana case dismissing the bill for non-infringement. The Court of Appeals, in denying the injunction and dismissing the bill on the ground that there appeared in the structure there involved changes from that which had been passed upon by the Court in Indiana, again referred to the limitations of the "closed corridor" and the directed air currents of the Smith patent.

Buckeye Incubator Co. et al. v. *Wolf,* 296 Fed. 680.
Buckeye Incubator Co. v. *Petersime,* 19 Fed. [2d] 721.
Buckeye Incubator Co. et al. v. *Blum,* 27 Fed. [2d] 333.
Buckeye Incubator Co. et al. v. *Boling,* 46 Fed. [2d] 965.

Respondents have never made and sold incubators without the "closed corridor".

No Court, prior to the instant case, has ever held a defendant for infringement of this claim, where the corridor and side egg chamber and egg arrangement and positioning described and pictured in the Smith patent, were not in all substance employed. Nor in any prior published adjudication where non-infringement was found (and they have preponderated) was the defendant's practice as remote from the Smith patent disclosure as is that of petitioner.

Petitioner's Incubator and its Manner of Use.

Petitioner's incubator is unlike the structure of the Smith patent in that it does not embody a closed central corridor and side egg tiers in closed chambers separated from the corridor by curtains. It is a single open structure containing the egg tiers, and does not have any "corridor" or compartments at all. Unlike the Smith structure, there are two fans; these are located on the rear

wall of the incubator, not at the top of a closed corridor. The air stream travels from the center of the fans towards the tips of the fan blades, strikes the walls, ceiling and floor, moves forward along them, strikes the front wall, and then in broken-up currents returns rearwardly between the trays, to the eyes of the fans. The air stream does *not* move *down* through a corridor, and *up* through mesh-bottomed trays stacked in a closed compartment.

As intimated above, with the patent in suit, the eggs nearest hatching are at the bottom; they are the warmest and give off heat to the current of air which *first* blows against them. This added heat, carried by ascending current of air, is imparted to the newer eggs which are below the standard temperature and require heat to be added in order to incubate. Thus the patented method "arranges them [the eggs] at different levels" and "the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage". The claim is thus clearly understandable, and is inapplicable to a practice in which the eggs trays are set promiscuously; and in which the air currents, being passed rearwardly across them, *between* the trays and not *through* them, do not carry the units of heat from eggs of advanced stage to those of less advanced stage. Defendant's eggs are not arranged, or changed, according to their stages of incubation, but are set promiscuously and remain where set until hatching. The drawings of the original Robbins patent (now reissued, *supra,* p. 2), (Vol. 2, p. 459), illustrate petitioners incubator, with only *one* chamber, the partition *10* not being used.

Reasons Relied on for Allowance of the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds, as set forth in Rule 38 of this Court:

1. The decision of the Circuit Court of Appeals for the Ninth Circuit sought to be reviewed is in direct conflict, as

to the scope of the claim in suit, with the decisions of the Courts of Appeals for the Third, Sixth and Eighth Circuits.

2. The decision of the Court of Appeals sought to be reviewed is in direct conflict with applicable decisions of this Court in that it sustains claim 1 of the patent and accords to the patentee a monopoly on a so-called method of operation of an incubator. The claim is stated solely in terms of function or result, which function can be realized only by the apparatus disclosed in the specification and drawings of the patent in suit.

3. The decree of the Court of Appeals sought to be reviewed is inconsistent with statements and admissions made by the patentee during the prosecution of the application for the patent in suit, and accords to the sustained claim a scope for which respondents are estopped to contend by reason of the assertion, rejection and cancellation of broad method claims.

4. The prior art is such as to limit the claim, if valid at all, to the narrow construction which the Court below rejected and other Courts of Appeal have given it.

5. Petitioner is advised that plaintiff Samuel B. Smith in said *Snow et al.* v. *Smith,* has petitioned this Court for certiorari to the Eighth Circuit Court of Appeals in that case. This would seem to concede that certiorari as herein petitioned is not opposable by respondents.

WHEREFORE your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, sitting at San Francisco, California, commanding said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record and all proceedings of said Circuit Court of

Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that said judgment of said Circuit Court of Appeals be reversed as to said claim 1 and that your petitioner be granted such other and further relief as may be proper.

Dated: July 20, 1934.

HERBERT H. WAXHAM,
By DRURY W. COOPER,
RAYMOND I. BLAKESLEE,
ALLAN C. BAKEWELL,
Counsel for Petitioner.

STATE OF NEW YORK }
County of New York } ss.:

ALLAN C. BAKEWELL, being duly sworn, deposes and says, that he is of counsel for the petitioner herein; that he is familiar with the record and has read the foregoing petition, and that the allegations thereof are true as he verily believes.

ALLAN C. BAKEWELL.

Subscribed and sworn to before me this 20th day of July, 1934.

M. E. McNINCH

Notary Public
New York County
Certificate No. 101
Register No. 5Mc3

(Seal)

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Statement.

The facts are stated in the petition. We emphasize that the Circuit Courts of Appeals for the Third, Sixth and Eighth Circuits are right in holding that the claim in suit must be construed in the light of the specification and drawings and that it is not entitled to a construction sufficiently broad to read on the operation of an incubator which does not have a central corridor closed by curtains which form separate air passageways in the corridor and in the egg tier chambers, and which does not have the warmest eggs at the bottoms of the tiers, and in which the air from the fan does not travel in definite paths and channels and first engage the warmest eggs. The specification will support no other construction. Claim 1 can not be accorded a construction sufficiently broad to read upon petitioner's practice, by reason of estoppel in the Patent Office during the prosecution of the application. The claim is invalid as it attempts to claim in terms of method the mere function or result of the particular apparatus shown and described in the patent. Petitioner's incubator is covered by the later Robbins reissue patent.

Jurisdiction.

The date of the decision of the United States Circuit Court of Appeals to be reviewed is April 9, 1934 (Vol. 1, p. 671; reported 70 Fed. [2d] 457). Petition for rehearing was filed May 7, 1934 and denied June 15, 1934.

The statute under which jurisdiction of this Court is invoked is Judicial Code 240 (a) as amended by act of February 13, 1925 (U.S.C.A. title 28, Section 347).

Specification of Errors.

The specification of errors which your petitioner will urge if the writ of certiorari is granted are that the Circuit Court of Appeals for the Ninth Circuit erred (1) in finding claim 1 of patent No. 1,262,860 valid and infringed, (2) in failing to find that the claim in suit is not entitled to a scope sufficiently broad to read on the operation of petitioner's incubator, and (3) in failing to find the claim in suit invalid as the mere functional statement of the operation of the incubator shown and described in the patent or of the necessary function of any incubator (new or old) which has air blown into or through it.

ARGUMENT.

I.

The Disclosure of the Patent in Suit.

The specification of the patent clearly discloses a structure which has as an essential element *a central corridor closed by curtains* and separated from the egg tiers (Vol. 2, p. 4, lines 65 *et seq.*). The purpose of this structure is to guide and direct and confine the current of air *down* from the fan and *up* through the trays of eggs. In the operation of his incubator, Smith describes and makes essential the progressive downward shifting, every three days, of the egg trays, and the more advanced and warmer eggs will be *at the bottom of the tiers* so that the stream of air which comes down through the closed corridor and into the closed egg tiers *must* first strike the warmest eggs in the hatching stage and be carried up through the cooler eggs, progressively (Spec. Vol. 2, p. 5, lines 60-73; 79-96):

> "• • • so as to compel the air to circulate through the mesh bottom and around and about each egg as here-

tofore referred to, and as the eggs further advanced in incubation are contained in these lower trays and as the danger is that the temperature will rise in these eggs to a point injurious to incubation the improved method disclosed herein permits the circulating air to act as a medium to prevent the over heating at this stage of incubation and this is accomplished by promoting an induced draft within the lower trays. * * *"

"It, therefore, appears that the improved apparatus and method contemplates the application of hot air circulating in a column with such speed as to keep the temperature substantially uniform and so arranging the eggs that the fresh eggs are placed at one point in the column of air and held in a horizontal plane until they reach a predetermined stage of incubation and then put at a different point in the same column of air and kept in planes inclined to the horizontal and thereafter placed at such a point in the column of air that the forced draft of air acts to hold the eggs at a uniform temperature and to prevent them from becoming overheated and thereafter placing the eggs into final position for the hatching operation."

II.

Claim 1 is Invalid as the Mere Function of the Disclosed Apparatus.

All of the appellate courts which have had the Smith patent before them, except the Court of Appeals for the Ninth Circuit in the instant case, have recognized the essentials of the Smith disclosure and have noted that the function specified in claim 1 was capable of being carried into effect only when the structure of the Smith patent is utilized. The specification and the history of the prosecution of the application as contained in the file

wrapper of the patent (Vol. 2, p. 317, *et seq.*) make it clear that in the practice of the method which Smith sought to claim in claim 1, his exact structure was a necessary requirement (70 Fed. [2d] at 568, C. C. A. 8):

> "The arrangement of the air currents ('columns') is repeatedly stated to be such as to carry the heat given off from the advanced eggs to those less advanced. When this is considered in connection with the above arrangement of eggs at various stages of incubation, it is difficult to see how the desired results can be secured except by a current of air passing first through the trays containing the most advanced eggs. That is the way appellee has devised his apparatus; it is the only way revealed by the patent or in practice; and it is successful.
>
> "Claim 1 (and, also, claim 2) must be so limited to preserve either of them."

The law is clear that a method claim must be independent of the particular mechanism for performing it. A patentable method must consist of a novel series of steps of operation. When a method is merely the necessary function of a machine, it is not patentable. Likewise, the mere result accomplished by a machine is not patentable. Anyone is free to devise a new method of accomplishing the same result, or to construct a new apparatus capable of realizing the same function.

The claim in suit purports to cover the mere function of the structure which is claimed in terms of apparatus in other claims of the patent (not here in suit) and is invalid.

Corn Planter Case, 69 U. S. 320, 328.
O'Reilly v. *Morse,* 15 Howard, 62, 113.
Risdom Iron and Locomotive Works v. *Medart,* 158 U. S. 68, 77.
Busch v. *Jones,* 184 U. S. 598.
Expanded Metal Co. v. *Bradford,* 214 U. S. 366.
Holland Furniture Co. v. *Perkins Glue Co.,* 277 U. S. 245.

III.

The File Wrapper and Contents of the Smith Patent Limits the Scope of Claim 1.

It is unnecessary to discuss the incubator art prior to Smith, for respondents' witnesses admitted that large incubators using a forced circulation of air were old (Vol. 1, pp. 531-533). Likewise, staged incubation was old long prior to Smith and his contribution to the art, if any, lay in his particular form of *closed corridor* and his *directed air currents.* The particular location and arrangement of egg trays which he describes are essential and were made a specific limitation in the claim in suit as finally allowed by the Patent Office:

> "* * * the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage for the purpose specified."

It will be noted that the air must first strike the *hottest* eggs—those in *the* (not *a*) more advanced stage.

Applicant first asserted in his application broad claims in terms of method, but these were rejected by the Patent Office on the prior art. Smith then amended his specification to more clearly define the circulation of air currents from the warmer eggs in the more advanced stages of incubation to the newer and cooler eggs (Vol. 2, p. 4, lines 40-54). After further rejection of broad claims he acquiesced in the rejection, cancelled all of them and asserted (among others) the claim which issued as claim 1 in suit (file wrapper, Vol. 2, p. 317 *et seq.*). The terminal phrase of this claim, which we have just quoted is a limitation which was made necessary by requirement of the Patent Office before it would allow the claim; under settled law the limitation may not be disregarded for the purpose of making out a case of infringement. Smith's particular

location of the egg trays is essential and defendant does not infringe claim 1 for it does not locate its egg trays in accordance with the requirement of the claim, nor direct the air from a fan first to the warmer eggs to carry heat therefrom to progressively cooler eggs with a definite temperature-equalizing tendency.

Goodyear Dental Vulcanite Co. v. *Davis,* 102 U. S. 222.

Shepard et al. v. *Carrigan,* 116 U. S. 593, 597.

Weber Electric Co. v. *Freeman Electric Co.,* 256 U. S. 668, 677:

> "Having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer of rotation as an operative feature of his device. • • •"
>
> "For the reasons thus elaborated, we conclude that the socket of the respondent does not infringe the fourth claim of the patent in suit • • • because the file-wrapper and the subsequent patent show that the disclosure is, and was intended to be, limited to a construction operative by direct longitudinal movement or thrust without such rotative movement."

The Third Circuit Court of Appeals in the *Hillpot* case emphasized the fact that the proceedings in the Patent Office placed necessary limitations upon the interpretation of claim 1 (24 Fed. [2d] at 344):

> "There can be little doubt about that. The file wrapper clearly shows that Smith was forced at different stages of the patent prosecution so to limit his claims. Moreover, the file wrapper points to the fact that the 'curtains' make 'a tight closure between the corridor and the compartments'; it speaks of 'air passageways' and 'vertically directed current'; it contains ten references to 'forced circulation of heated air', six to circulation effected by 'currents' of

> heated air, six to 'columns of heated air' through 'columns of egg trays,' and it contains no reference to any other kind of air circulation. Yielding to the demand of the Patent Office that the 'circulation of air shall be included and defined,' Smith acquiesced in repeated rejections of his claims, proposed others and finally accepted those allowed, in each of which is embodied the conception of air movement by currents in defined channels."

Likewise, the Court of Appeals for the Sixth Circuit recognized that the patentee is estopped to change its position from that which it had urged in the Patent Office when seeking the grant (*Buckeye* v. *Blum*, 27 Fed. [2d] 333, 334):

> "Whether there is such a *fairly distinct current, as distinguished from the general agitation employed by the defendant* here, and in less degree by the defendant in the Petersime Case, is said to be of no practical importance in achieving the successful result. Perhaps so; and yet *dependence upon that theory, in order to sustain the patent, is required, both by the proceedings in the Patent Office and by the prior art,* including Smith's too old public use. Smith learned or knew he must differentiate in this respect in order to get his patent."

It seems unnecessary to review the prior art at this time. Its existence and pertinency are indicated in the foregoing quotation as well as in the citations and discussions in the Patent Office proceedings which preceded the grant of the patent.

IV.

Petitioner's Incubator Does Not Infringe Claim 1.

Petitioner operates an incubator which does not have the closed corridor of the Smith patent and does not have the closed egg tiers which form passageways for the direction of the air in definite channels. These structural features are essentials of the Smith patent. Furthermore, in the operation of petitioner's incubator, the egg trays are not progressively shifted to lower positions in the egg tiers so as to have the warmer eggs which are in the more advanced stages of incubation at the bottom of such tiers for first engagement by air from a fan. Petitioner locates the trays with new eggs at random in a rack in a single open chamber and does not alter their location during the incubation period. Petitioner's incubator does not embody the indispensable structure of the patent and in its operation it does not follow the essential steps disclosed in the specification—*e. g.*, does not "arrange them at different levels", so as to secure the result specified in the last clause of the claim in suit:

> "• • • the units of heat will be carried from the eggs in *the* more advanced stage of incubation to those of a less advanced stage for the purpose specified."

Petitioner's incubator operates under the later Robbins reissue patent, which does not follow the Smith patent theory or practice.

Corning v. *Burden*, 56 U. S. 252.

Petitioner does not infringe the claim in suit, and the decree of the Court of Appeals in the present case is in direct conflict with that of the Court of Appeals for the Eighth Circuit (70 Fed. [2d] 564) in a suit in which the incubator in question is substantially identical with that

of petitioner here. The decision of the Court of Appeals sought to be reviewed is also in direct conflict with the decisions of the Courts of Appeals for the Third and Sixth Circuits.

V.

The Following Authority Justifies the Grant of the Writ Prayed For.

Conflict of decision between Circuit Courts of Appeals on the question of proper construction of a claim and infringement of that claim, as in the present case, has been recognized by this Court as ground for the grant of a writ of certiorari.

Weber Electric Co. v. *Freeman Electric Co.*, 256 U. S. 668, 669.
Holland Furniture Co. v. *Perkins Glue Co.*, 277 U. S. 245, 246.

From the foregoing it appears that the Circuit Court of Appeals for the Ninth Circuit has rendered a decision which is in conflict with the decisions of three other Circuit Courts of Appeals and which has seriously prejudiced the rights of your petitioner and injuriously affected an important and nation-wide industry.

Respectfully submitted,

HERBERT H. WAXHAM,
By DRURY W. COOPER,
RAYMOND I. BLAKESLEE,
ALLAN C. BAKEWELL,
Counsel for Petitioner.

Dated: July 20, 1934.

Notice of Presentation of Petition.

PLEASE TAKE NOTICE that the foregoing petition for a writ of certiorari and brief was filed with the Clerk of the Supreme Court of the United States in the City of Washington, D. C., on July , 1934.

Dated: July , 1934.

To:

ALBERT L. ELY, Esq.,
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Due and timely service of a copy of the within petition for certiorari and brief, together with a copy of the printed record and a notice that the petition had been filed with the Clerk of the Supreme Court of the United States, at Washington, D. C., on July , 1934, is hereby acknowledged this day of July, 1934.

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Attorneys for Respondents.